



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,119	04/16/2004	Toyoko Kusama	NANP119US	1349
7590		10/02/2007		
Gregory Turocy Amin & Turocy, LLP 24th Floor, National City Center 1900 East 9th Street Cleveland, OH 44114				
			EXAMINER CHUNDURU, SURYAPRABHA	
			ART UNIT 1637	PAPER NUMBER
			MAIL DATE 10/02/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/826,119

Applicant(s)

KUSAMA ET AL.

Examiner

Suryaprabha Chunduru

Art Unit

1637

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 September 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: none.
Claim(s) objected to: none.
Claim(s) rejected: 24, 25 and 35.
Claim(s) withdrawn from consideration: 1-23, 26-34, 36 and 37.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


SURYAPRABHA CHUNDURU
PRIMARY EXAMINER

Suryaprabha Chunduru
Primary Examiner
Art Unit: 1637

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' arguments are found unpersuasive. With regard to the claims 24-25, 35 rejected under 35 USC 103(a) as being obvious over Saulle in view of Lowe et al., Applicants argue that Saulle et al. merely teaches a nucleic acid sequence of a region encoding ATPase8 gene and Lowe et al. et al. merely teaches a computer program for rapid selection of primers for PCR. Applicants assert that to identify a primer to detect DNA a specific portion of the genome sequence, a specific length of the sequence and a specific combination of these sequences must be selected and neither Saulle et al. nor Lowe et al. satisfy none of these requirements. Applicants' arguments are found unpersuasive. First, to design a primer pair to detect a specific target sequence one skilled in the art would require a known target sequence. In the present context the specific target sequence comprising ATPase8 gene is known in the art as taught by Saulle et al. Second to design a pair of primers one skilled in the art would require selection of a specific target region from the known sequence as taught by Lowe et al., wherein Lowe et al. explicitly taught designing primers to detect a specific target sequence from the known nucleic acid sequence. Thus Saulle et al. in view of Lowe et al. meets the requirements as asserted by the Applicants.

Applicants further argue that Saulle et al. does not teach or suggest primers that discriminate between homologous ATPase8 targets and the software of Lowe et al. generates all possible primers from a single user inputted target sequence therefore one skilled in the art might expect that the primers are capable of amplifying an ATPase8 target, but can not discriminate between two homologous ATPase8 targets. Applicants also assert that the combination of Saulle et al. in view of Lowe et al. would generate numerous infinite number of primer pairs that would require undue experimentation to derive a primer pair that can discriminate between two homologous ATPase8. Applicants' arguments are found unpersuasive. First, the target ATPase 8 gene taught by Saulle et al. is a known sequence and the primer combination generated by using the known sequence would generate finite number of primer pairs not infinite as asserted. Such primer pairs flanking the target region would amplify the target region that comprises a variation or without variation in that target region, which would discriminate between the species. With regard to undue experimentation Examiner notes that the MPEP 2144.08 states "obviousness does not require absolute predictability, only a reasonable expectation of success; i.e., a reasonable expectation of obtaining similar properties. See, e.g., In re O'Farrell, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988)." In this factual case, there is express suggestion in the prior art to design a primers from a known target sequence and Lowe et al. explicitly taught that all primers designed for over 10 gene products were experimentally tested and the results showed that all the amplification products specified by the primers are of the predicted size (see page 1760, col. 2, paragraph 1). This is sufficient for a reasonable expectation of success. The MPEP cites In re O'Farrell, which notes regarding "obvious to try" at page 1682, that, In some cases, what would have been "obvious to try" would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful. E.g., In re Geiger, 815 F.2d at 688, 2 USPQ2d at 1278; Novo Industri A/S v. Travenol Laboratories, Inc., 677 F.2d 1202, 1208, 215 USPQ 412, 417 (7th Cir. 1982); In re Yates, 663 F.2d 1054, 1057, 211 USPQ 1149, 1151 (CCPA 1981); In re Antonie, 559 F.2d at 621, 195 USPQ at 8-9. In others, what was "obvious to try" was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it. In re Dow Chemical Co., 837 F.2d, 469, 473, 5 USPQ2d 1529, 1532 (Fed. Cir. 1985); Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1380, 231 USPQ 81, 90-91 (Fed. Cir. 1986), cert. denied, 107 S.Ct. 1606 (1987); In re Tomlinson, 363 F.2d 928, 931, 150 USPQ 623, 626 (CCPA 1966). Thus some undue experimentation with trial and error is permissible in determining obviousness. Accordingly the rejection is maintained herein.